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In re Application of: HUO, Shuya
Application No.: 10/519,393
PCT Application No.: PCT/US03/11320
Int. Filing Date: 14 April 2003
Priority Date Claimed: 16 April 2002
For: ELECTRONIC INFORMATION ITEM
SELECTION FOR TRADE AND TRADED
ITEM CONTROL DELIVERY SYSTEM

DECISION ON
PETITION UNDER
37 CFR 1.137(a)

This decision is in response to the letter received on 28 November 2005, which is being treated as a Renewed Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidably under 37 CFR 1.137(a). The petition is **DISMISSED**.

BACKGROUND

On 14 April 2003, applicant filed international application PCT/US03/11320 which claims a priority date of 16 April 2002 and designates the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 October 2003. The deadline for paying the basic national fee in the United States was thirty months from the priority date, that is, 16 October 2004. The application became abandoned at midnight 18 October 2004 (16 October 2004 being a Saturday) for failure to pay the basic national fee.

On 21 December 2004, applicant filed a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidably under 37 CFR 1.137(a) accompanied by, *inter alia*, a transmittal letter for entry into the US national stage under 35 U.S.C. 371, a copy of the international application, an executed declaration, and a money order in the amount of \$115.

On 22 September 2005, the petition was dismissed because (1) applicant had failed to pay the basic national filing fee of \$150, effective 08 December 2004, (2) the applicant had failed to pay the petition fee of \$250 as set forth in § 1.17(l), effective 08 December 2004, and (3) the applicant had failed to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable.

On 28 November 2005, applicant filed the current communication accompanied by, *inter alia*, a check for \$235.

DISCUSSION

37 CFR 1.137(a), governing the revival of abandoned applications under the *unavoidable* standard, states:

A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Applicant has satisfied item (4), since a terminal disclaimer is not required for a utility application filed after 08 June 1995.

As to item (1), a copy of the international application has been filed; however, the required basic national fee has not been paid. A money order for \$115 was received; however, the basic national fee due from applicant is \$150; see Fee Code 2631, effective 08 December 2004. Thus, applicant has not met the requirement under 37 CFR 1.137(a)(1). \$100 of the initial payment of \$115 has been credited toward payment of the basic national fee, leaving a balance due of \$50.

As to item (2), the decision of 22 September 2005 indicated that a petition fee of \$65 was received; however, the fee history of the application fails to indicate receipt of the petition fee. Furthermore, the required petition fee due from the applicant is \$250; see Fee Code 2452, effective 08 December 2004. Since the fee history indicates an initial payment of \$115, the payment of \$235 on 28 November 2005, in combination with \$15 of the initial payment of \$115, is sufficient to meet the requirement under 37 CFR 1.137(a)(2) for the petition fee as set forth in § 1.17(l). The balance of the initial payment is credited toward payment of the basic national fee, as indicated in the above paragraph.

As to item (3), this application became abandoned for failure to pay the basic national fee prior to thirty months from the priority date, i.e., prior to midnight 18 October 2004 (16 October 2004 being a Saturday). Petitioner states that Mark McCabe and Tarek Fahmi of the law office of Blakely, Sokoloff, Taylor & Zafman LLP were employed to handle all patent matters before the Office and that petitioner was not notified by counsel of the International Preliminary

Examination Report until 29 November 2004. Petitioner further states that Mr. Fahmi indicated to the applicant via email that December 15 was the deadline for filing the national stage application. Petitioner provides copies of email correspondence from Tarek Fahmi dated 03 December 2004 and 30 November 2004 indicating December 15 as the filing deadline for the national stage application.

The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. *Link v. Wabash*, 370 U.S. 626, 633-34 (1962). Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891).

Hence, petitioner's delay caused by either the belated notification to the applicant by counsel of the International Preliminary Examination Report or the miscalculation by counsel of the deadline for filing the national stage application, does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). While the Notification of Transmittal of the International Preliminary Examination Report (PCT/IPEA/416) reminds the applicant of the need to perform certain acts within the applicable time limit in order to enter the national phase, the acts and time limit for entering the national phase in the United States are set by 37 CFR 1.495. The Notification serves merely as a reminder to the applicant of the applicant's responsibility. The applicant is responsible for meeting the applicable deadline, regardless of whether the applicant has timely received a reminder to do so. While the miscalculation by counsel of the deadline may have contributed to the delay in paying the US basic national fee, there is no showing of record that the error in calculation was due to unavoidable causes. Accordingly, the petitioner has failed to meet his burden of establishing an unavoidable cause of the delay.

An adequate showing of unavoidable delay must include a showing from counsel as to why action was not taken to prevent the application from becoming abandoned while the application was under his control. Petitioner should send a letter (accompanied by a copy of this decision) to Tarek Fahmi by registered or certified mail, return receipt requested, indicating to counsel that the PTO is requesting his assistance in determining the circumstances surrounding the abandonment of this application, and is specifically requesting that he provide a statement as to (1) what procedures were in place to ensure that the national stage application be timely filed, (2) how December 15 became identified as the deadline for filing the national stage application, (3) when counsel first became aware of the true deadline for filing the national stage application, and (4) what steps were taken upon realizing that the deadline for filing the national stage application had expired. Such statement should be accompanied by copies of any documents (e.g., docket records) relevant to the procedures in place to ensure that the national stage application be timely filed. In the event that counsel fails to provide a statement within a period (e.g., within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to counsel with any renewed petition under 37 CFR 1.137(a).


Petitioner may yet obtain relief by filing a petition for revival on the basis of unintentional delay pursuant to 37 CFR 1.137(b). A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) a proper reply, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Full payment of the basic national fee constitutes a proper reply for entry into the national stage. A blank form for a Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137(b) (PTO/SB/64/PCT) is attached for applicant's convenience.


CONCLUSION

The petition for revival of an international application abandoned unavoidably under 37 CFR 1.137(a) is **DISMISSED** as to the national stage in the United States of America.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mailing date of this Decision. Applicant can submit appropriate evidence in accordance with 37 CFR 1.137(a) or request other appropriate relief, e.g. a petition to revive under 37 CFR 1.137(b). The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time under 37 CFR 1.136(a) are available.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

*2700
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Attachment: Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137(b) (PTO/SB/64/PCT).